IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Date: May 16, 2005
Express Mail: ED582681615US

In re application of: **U. Hansmann, et al**

Serial No.: **09/602,261**

Filed: **June 23, 2000**

Docket No.: **DE919990047-US1**

Board of Patent Appeals and Interferences
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF UNDER 37 CFR 41.37

Sir:

Transmitted herewith is an Appeal Brief with respect to the Notice of Appeal filed March 14, 2005 for the above-identified patent application. This Appeal Brief is being filed on behalf of other than a small entity. Authorization is given to charge amount of $500.00, for filing a Brief in support of appeal in accordance with 37 CFR 41.20(b), to Deposit Account 50-0510. The Commissioner is hereby authorized to charge any required additional fee deemed necessary to perfect the filing of this document and to charge back any overpayment to Deposit Account No. 50-0510. This transmittal letter is intended to take the effect of any petition deemed necessary to perfect filing of the accompanying document.

Respectfully submitted,
Hideki Tai, et al

Anne Vachon Dougherty
Registration No. 30,374
Tel. (914) 962-5910

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS
BEING DEPOSITED IN EXPRESS MAIL AS
EXPRESS MAIL: ED582681615US ON
DATE OF DEPOSIT: May 16, 2005
PERSON DEPOSITING: ANNE VACHON DOUGHERTY

Anne Vachon Dougherty 5/16/05
Signature & Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of	:	May 16, 2005
U. Hansmann, et al	:	Group Art No.: 2126
Serial No. 09/602,261	:	Examiner: S.J. Courtenay III
Filed: June 23, 2000	:	for IBM Corporation Anne Vachon Dougherty 3173 Cedar Road Yorktown Hts, NY 10598
Title: METHOD AND APPARATUS FOR THE USER-DEFINED LOADING AND RUNNING OF APPLICATIONS BY MEANS OF A TOKEN		

Board of Patent Appeals and Interferences
Washington, D.C. 20231

APPEAL BRIEF (37 CFR 41.37)

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the decision dated November 12, 2004 of the Primary Examiner finally rejecting Claims 1-31 in the above application, and respectfully request that the Board

of Patent Appeals and Interferences consider the arguments presented herein and reverse the Examiner's rejection.

I. REAL PARTY IN INTEREST

The appeal is made on behalf of Appellants who are real parties in interest with respect to the subject patent application.

II. RELATED APPEALS AND INTERFERENCES

There are no pending related appeals or interferences with respect to the subject patent application.

III. STATUS OF CLAIMS

There are thirty-one (31) claims pending in the subject patent application, numbered 1-31. No claims stand allowed. All of Claims 1-31 stand rejected. All of Claims 1-31 are the subject of this appeal.

A complete copy of the claims involved in the appeal is attached hereto.

IV. STATUS OF AMENDMENTS

No amendments have been filed subsequent to final rejection. There are no unentered Amendments outstanding in the prosecution of the application.

V. SUMMARY OF INVENTION

The present application teaches and claims a method and apparatus for the user-defined loading and running of applications by means of a token. Under the present invention, a user has a token comprising a user specific unique identifying attribute, preferably on a chip card, whereby the token uniquely identifies the user customized application and whereby the token communicates with the data processing device to obtain and display the user customized application to the user. The application may be "user customized" with regard to settings for applications (see: page 4, lines 16-19 and page 10, lines 3-5), additional data and/or cardholder preferences (page 6, lines 1-3), service identifiers for a card agent and registers (page 7, lines 17-19), personalized presentations (page 8, lines 9-14), and/or user defined combined applications (page 8, lines

17-20). The Specification contains multiple references to the user personalization (page 8), user customization (pages 3 and 8 and the Abstract), and user defining (pages 1, 4, 8 and 9 and the Abstract). All of the pending claims expressly recite the token having the user specific unique identifying attribute and the use thereof for configuring applications.

VI. STATEMENT OF ISSUES OF APPEAL

The grounds of rejection to be reviewed on appeal are as follows:

The Examiner has rejected Claims 1, 9, 17, 27, 28, 30, and 31 under 35 USC 103 as being unpatentable over Fowlow in view of Chen; Claims 2-8, 18, 21-23, and 29 under 35 USC 103 as unpatentable over the teachings of Fowlow and Chen in view of Powers; Claims 10-13, and 15 under 35 USC 103 as being unpatentable over the teachings of Fowlow and Chen in view of Wallace; Claims 14 and 24-26 as being unpatentable over Fowlow and Chen in view of Powers, Wallace and Perlman; Claim 16 as unpatentable over Fowlow in view of Chen, Powers and DiGiorgio; and, Claims 19-20 as being unpatentable over Fowlow in view of Chen, Wallace and DiGiorgio.

The Issue on appeal are:

(1) that the Examiner has erred in applying the teachings of the Fowlow patent to the language of the independent claims;

(2) that the Examiner erred in interpreting the teachings of the Chen patent;

(3) that the Examiner has erred in concluding that the combination of teachings from the Fowlow and Chen patents obviates the invention as claimed in Claims 1, 9, 17, 27, 28, 30, and 31; and

(4) that the Examiner erred in concluding that Claims 2-8, 18, 21-23, and 29 are unpatentable over the teachings of Fowlow and Chen in view of Powers; in rejecting Claims 10-13, and 15 under 35 USC 103 as being unpatentable over the teachings of Fowlow and Chen in view of Wallace; in rejecting Claims 14 and 24-26 as being unpatentable over Fowlow and Chen in view of Powers, Wallace and Perlman; in rejecting Claim 16 as unpatentable over Fowlow in view of Chen, Powers and DiGiorgio; and, in rejecting Claims 19-20 as being unpatentable over Fowlow in view of Chen, Wallace and DiGiorgio.

VII. ARGUMENT

ARGUMENT (1)

The Examiner has erred in applying the teachings of the Fowlow patent to the language of the independent claims.

The Fowlow patent, U. S. Patent 6,260,078, is directed to a system and method for using a distributed object system to find and download Java applications. Under the Fowlow system, a client obtains the name of a base class, queries a naming service to determine which class server contains the needed base class, requests the code for the base class from the class server, and then retrieves the code either by reading the file locally or by repeating the process to locate and read the code from one or more than one different server. The client may access the class servers through an object request broker. It may further be necessary, under Fowlow, for the class servers to gather "unresolved" classes (Col. 13, lines 46-54) for provision to the client.

The Fowlow system and method is predicated on the underlying assumption that a client has unrestricted access to each class server and to the information stored thereon, and does not require a user-specific identifying attribute to gain access to the server and applications. Further,

under Fowlow, it is presumed that the client knows the class name for obtaining access to any application in that class. The Fowlow client does not seek access to a user customized application from a class. Rather, the Fowlow client seeks to locate an application in a class using the generic class name. There is nothing in Fowlow which either teaches or suggests that a client seeks access to a user customized application, let alone that a client has a unique token which can communicate with other entities to obtain access to a user customized application.

Under the Fowlow process, a client knows the class name (see: Col. 13, lines 3-5) but does not have any unique information to use in obtaining access to an application. The Fowlow client undertakes a multi-step process by which the client finds the class server and obtains the code for the base class. The Fowlow client does not, however, have any identifying information which uniquely represents client access to the code and which interacts with a data processing device for obtaining customized code. The Fowlow class name is not the same as nor suggestive of the unique identifying attribute, each unique application identifying attribute being user specific and being provided to call up at least one user customized software comprising at least

one of an application identified by the unique application identifying attribute and software components to form the application of the present invention.

The language of the independent claims expressly recites the token as a "non-volatile memory for storing at least one unique identifying attribute, each unique identifying attribute being user-specific and being provided to call up at least one user-customized software comprising at least one of the application identified by the unique identifying attribute and software components to form said application." The Examiner has interpreted the computer apparatus of Fowlow to be "[t]he token storing at least one unique software attribute, each attribute being provided to call up at least one software...comprising one of the application identified by the attribute and software components to form the application" (see, page 3, subparagraph (a)). Appellants first note that the Examiner has restated the claim language to eliminate the "user-specific" and "user-customized" terms, which will be discussed further below with regard to the additionally-cited Chen patent. Appellants next note that the Examiner nonetheless concludes that the computer apparatus is a token which stores a *unique* software

attribute, with the attribute being the class name. Appellants respectfully argue that a class name is not an attribute which is unique to a particular, possibly customized, instantiation of a software application. Rather, the class name represents more than one application by application type and is used by Fowlow to assemble the desired software ("to load and resolve all necessary classes...over a distributed network" from Col. 14, lines 1-3). Appellants conclude that Fowlow is not teaching the existence or use of a unique attribute, as claimed. Accordingly, Appellants conclude that the Examiner erred in applying the Fowlow teachings to the claim language.

Appellants further assert that the Examiner has erred in applying the teachings of the Fowlow patent to the additionally-recited claim features of (b) an apparatus for establishing communications between the token and a data processing device, and (c) a data processing device comprising software, a register and an agent for establishing communications between the token and the software. Specifically, the Examiner has cited the same Fowlow recitation of an object request broker, found in the claims at Col. 16, lines 43-47, against the two different claim features (b) and (c). Clearly, the one Fowlow object

request broker cannot be both the apparatus for establishing communications between the token and the data processing device, as well as the communications agent of the data processing device for establishing communications between the token and the software. Appellants respectfully conclude that the Examiner has erred in applying the foregoing Fowlow teachings to the claim language.

ARGUMENT (2)

The Examiner erred in interpreting the teachings of the Chen patent and in concluding that the Chen patent teaches that a user has a token comprising a user-specific identifying attributed for establishing access to user customized applications.

The Examiner has acknowledged that the Fowlow patent does not explicitly teach a token comprising a user-specific identifying attribute for establishing access to user customized applications, and has cited the Chen patent, U.S. Patent 5,784,463, in combination with Fowlow. The Chen patent is directed to a method for authentication token distribution and use in connection with a shared secret key

application level security system. Under Chen, an authentication token provides the user with "flexibility in selecting gateways and applications with which the token is to be used" (Col. 2, lines 30-34). By not preseeding a token with a shared secret key, "the authentication token can be used by the client to register for any application offered by servers in possession of the private key" (Col. 2, lines 56-59). Chen also provides for dynamic configuration of a client system in response to changing user entitlements (Col. 3, lines 24-26) including use of software on different systems and/or at different locations (Col. 6, lines 4-5). Essentially, Chen provides a client with a token for contacting an authentication server from any client machine in order to access any application offered by the servers. The token of Chen is not, therefore, a unique identifying attribute being user-specific and being provided to call up user-customized software. Rather, as expressly taught by Chen at Col. 2, lines 56-59, the "not preseeded" token enables a client to register for any application offered.

Appellants respectfully assert that the Chen patent does not teach or suggest the claimed token. Chen provides a client with a token for contacting an authentication

server from any client machine in order to access any application offered by the servers. The token of Chen is not a unique identifying attribute which is user-specific and which is provided to call up user-customized software. Accordingly, Appellants conclude that the Examiner erred in interpreting the teachings of the Chen patent.

ARGUMENT (3)

The Examiner has erred in concluding that the combination of teachings from the Fowlow and Chen patents obviates the invention as claimed.

Appellants assert that the combination of the teachings of the Fowlow patent with the teachings of the Chen patent would not result in the invention as claimed. If one having skill in the art were motivated to modify Fowlow with Chen, one would arrive at a system wherein a client would be provided with a Chen non-preseeded token which would be used for authenticating the client to the server. After client authentication, the client would then access any application at the server (as taught by Chen) or send a class name to the server and proceed as before with Fowlow. Providing an authentication token for authenticating client access to a server would not obviate the invention as claimed, wherein a

token stores at least one unique identifying attribute, each unique identifying attribute being user specific and being provided to call up at least one user customized software comprising at least one of an application identified by the unique application identifying attribute and software components to form the application. Neither Fowlow nor Chen teaches or suggests a token which is user-specific for calling up at least one user-customized software.

Appellants respectfully assert that obviousness can only be established by references which either teach or suggest the claim features. Since neither of the cited references teach or suggest apparatus and methods for providing and using a token including at least one user specific unique identifying attribute to obtain at least one user customized software, it cannot be concluded that the claims are obviated by the cited art, alone or in combination. Since neither reference teaches the claim features, a *prima facie* case of obviousness simply has not been presented by the Examiner *(In re Wilson,* 424 F.2d 1382, 165 USPQ 494 (C.C.P.A. 1970)). Accordingly, Appellants respectfully maintain that the pending claims are patentable over the cited art and that the Examiner erred in concluding that the combination would obviate the invention as set

forth in independent Claims 1, 17 and 31, as well as Claims 9, 27, 28, and 30, which depend therefrom and add further limitations thereto.

ARGUMENT (4)

Appellants assert that the Examiner erred in concluding that Claims 2-8, 18, 21-23, and 29 are unpatentable over the teachings of Fowlow and Chen in view of Powers; in rejecting Claims 10-13, and 15 under 35 USC 103 as being unpatentable over the teachings of Fowlow and Chen in view of Wallace; in rejecting Claims 14 and 24-26 as being unpatentable over Fowlow and Chen in view of Powers, Wallace and Perlman; in rejecting Claim 16 as unpatentable over Fowlow in view of Chen, Powers and DiGiorgio; and, in rejecting Claims 19-20 as being unpatentable over Fowlow in view of Chen, Wallace and DiGiorgio.

Appellants rely on the arguments presented above with respect to the applicability of the Fowlow and Chen patent teachings to the independent claims, Claims 1, 17 and 31. Appellants respectfully conclude that none of the additionally-cited patents provide the teachings which are missing from the Fowlow patent. Specifically, none of the cited patents teaches or suggests that a user have a token

comprising a user specific unique identifying attribute for establishing access to user customized applications and for communicating with a data processing device to configure the user customized applications.

The Powers patent was cited for describing a chip card. Powers does not, however, provide any teachings regarding that chip card having a non-volatile memory for storing at least one user specific unique identifying attribute, as taught and claimed by the present application.

With regard to the Wallace patent, which has been cited for teaching a card reader that facilitates communication between a memory card and a host computer, Appellants aver that Wallace does not teach of suggest that the card reader obtains or uses a user specific unique identifying attribute for accessing an application for a user.

The Perlman patent has been cited for its teachings regarding discovering the peripheral technology required and obtaining the necessary drivers. Perlman does not, however, teach or suggest user customized software (e.g., drivers) being obtained using a user specific unique identifying attribute.

Finally, the DiGiorgio patent is directed to a secure access token device whereby a user is authenticated using

the token device. DiGiorgio uses the token to establish user access; however, it does not provide a user specific unique identifying attribute, each unique application identifying attribute being provided to call up at least one user customized software comprising at least one of an application identified by the unique application identifying attribute and software components to form the application.

Appellants respectfully reiterate that obviousness can only be established by references which either teach or suggest the claim features. Since none of the cited references teach or suggest apparatus and methods for providing and using a token including at least one user specific unique identifying attribute to obtain at least one user customized software, it cannot be concluded that the claims are obviated by the cited art, alone or in combination. Since none of the references teaches the claim features, a *prima facie* case of obviousness simply has not been presented by the Examiner *(In re Wilson,* 424 F.2d 1382, 165 USPQ 494 (C.C.P.A. 1970)). Accordingly, Appellants respectfully maintain that the pending claims are patentable over the cited art and that the Examiner erred in concluding that the combination would obviate the invention.

CONCLUSION

Appellants respectfully assert that the Examiner has erred in rejecting Claims 1-31 as unpatentable under 35 USC 103. Appellants believe that the references do not provide the teachings which the Examiner has suggested, and that the combination of patent teachings do not teach or suggest each and every claims feature.

In light of the foregoing arguments, Appellants request that the decision of the Examiner, rejecting all of the pending claims, be overturned by the Board and that the claims be passed to issuance.

Respectfully submitted,
U. Hansmann, et al

By: Anne Vachon Dougherty

Anne Vachon Dougherty
Registration No. 30,374
Tel. (914) 962-5910

APPENDIX OF CLAIMS

1. Apparatus for the user-defined configuring of applications on a data-processing system by means of a token, comprising the following components:

a) a token comprising a non-volatile memory for storing at least one unique identifying attribute, each unique identifying attribute being user-specific and being provided to call up at least one user-customized software comprising at least one of the application identified by the unique identifying attribute and software components to form said application, a volatile memory, and a microprocessor for processing data;

b) an apparatus for establishing communications between the token and a data-processing device; and

c) a data-processing device comprising at least one software comprising at least one of applications and software components to form an application, a register for registering the at least one software which is available on the data-processing device, and an agent for establishing

communications between the token and the at least one software.

2. Apparatus according to claim 1, wherein the token is a chip card.

3. Apparatus according to claim 1, wherein the token is a portable data-processing device.

4. Apparatus according to claim 3, wherein the portable data-processing device can take the form of at least one of a finger ring, an electrical plug, and a connector.

5. Apparatus according to claim 2, wherein the at least one identifying attribute allows the at least one software to be uniquely allocated to it.

6. Apparatus according to claim 5, wherein the identifying attribute includes address information for locating the software.

7. Apparatus according to claim 6, wherein the address information is provided in the form of a GUID and is stored in a file in the non- volatile memory of the chip card.

8. Apparatus according to claim 6, wherein the address information is shown in the form of a GUID and is stored in a file in the volatile memory of the chip card.

9. Apparatus according to claim 1, wherein the register is implemented in the form of at least one of a file, table and database on the data-processing device.

10. Apparatus according to claim 1, wherein the apparatus for establishing communication is implemented as at least one of a contactless-card reader and a contact-card reader.

11. Apparatus according to claim 1, wherein the agent is installed on a card reader.

12. Apparatus according to claim 1, wherein the agent is installed on the data-processing device.

13. Apparatus according to claim 1, wherein the agent is a program.

14. Apparatus according to claim 2, wherein the identifying attribute includes address information for locating the software and wherein the agent is a program that performs the following functions:

a) determining the card technology;

b) providing a driver associated with the card technology;

c) reading the address information on the card;

d) determining by reference to the address information whether the software is present on the data-processing device; and

e) establishing communications with at least one of a plurality of remote data-processing devices on which the software components are stored and downloading the latter to the data-processing device.

15. Apparatus according to claim 1, wherein the communication between token and agent takes place using the protocol for the particular token.

16. Apparatus according to claim 2, wherein the communication between chip card and agent takes place by means of APDU's.

17. Method for configuring applications on a user data-processing device by means of a token storing unique application identifying data, comprising the steps of:

a) establishing a communications connection between the token and the user data-processing device;

b) reading the unique application identifying data stored on the token to enable an agent to build and start a given application, each unique application identifying attribute being

user-specific and being provided to call up at least one user-customized software comprising at least one of an application identified by the unique application identifying attribute and software components to form said application;

c) determining whether software comprising at least one of the application and software components to form the application identified by said unique application identifying attribute is available at the user data-processing device by means of the identifying data; and

d) loading the software components to allow the allocated application to be built and started when not available at the user data-processing device.

18. Method according to claim 17, wherein the token is a chip card.

19. Method according to claim 18, wherein the communications connection between the chip card and data-processing device is obtained via a card reader.

20. Method according to claim 19, wherein the agent is installed on one of the card reader and the data-processing device.

21. Method according to claim 18 wherein the chip card has a non-volatile memory and further comprising storing the identifying data in a file in the non-volatile memory of the chip card.

22. Method according to claim 21 wherein said storing is conducted when the chip card is personalised.

23. Method according to claim 21 wherein said storing is conducted at the time of a first log-on to use an application.

24. Method according to claim 19, wherein said establishing communications comprises the steps of:

a) determining of the chip card technology by the agent; and

b) loading by the agent of the requisite driver software to allow communications with the chip card.

25. Method according to claim 24, wherein the driver software is loaded as part of the agent.

26. Method according to claim 24, wherein the driver software is stored separately from the agent on the storage medium of the user data- processing device and is started by the agent.

27. Method according to claim 17, wherein said determining comprises the following further steps:

comparing the identifying data stored in the user data processing device to the identifying data transmitted by the chip card;

inserting identifying data with an application to identify a software comprising at least one of application and software components when an application is being stored on the user data-processing device; and

loading the software components and starting of the allocated application, by the agent, when the sets of identifying data match.

28. Method according to claim 27, further comprising the steps of:

establishing a connection to a second data-processing device by the agent by means of the identifying data when the

identifying data do not match based on said comparing;

transferring the application found by means of the identifying data to the user data- processing system; and

adding the identifying data to the applications installed on the user data-processing device.

29. Method according to claim 28, wherein the identifying data includes address information in the form of a GUID.

30. Method according to claim 28 wherein the identifying data includes address information in the form of a URL.

31. A program storage device readable by machine, tangibly embodying a program of instructions executable by the machine to perform method steps for configuring applications on a user

data-processing device by means of a token storing identifying data, said method comprising the steps of:

a) establishing a communications connection between the token and the user data-processing device;

b) reading the unique application identifying data stored on the token to enable an agent to build and start a given application, each unique application identifying attribute being user-specific and being provided to call up at least one user-customized software comprising at least one of an application identified by the unique application identifying attribute and software components to form said application;

c) determining whether software comprising at least one of the application and

software components to form the application identified by said unique application identifying attribute is available at the user data-processing device by means of the identifying data; and

d) loading the software components to allow the allocated application to be built and started when not available at the user data-processing device.